THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte WILLIAM C. KIMBRELL

_____

Appeal No. 1997-0142
Application 08/373,721

_____

HEARD: Feb. 22, 2000

_____

Before GARRIS, PAK, and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 20 which are all of the claims pending in the application.

The subject matter on appeal relates to a method of

exhaust dyeing a textile article containing polyester fibers which have been previously treated with an aliphatic amine which includes the step of providing the dye bath with a harmonizing compound selected from the group consisting of certain types of ethoxylates. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. In a method of exhaust dyeing a textile article containing polyester fibers with a disperse dye, wherein the article has been previously treated with an aliphatic amine to reduce the tensile strength of the polyester fibers, the improvement comprising, providing in a dye bath at least 1.0 weight percent, based on the weight of the textile article, of a harmonizing compound selected from the group consisting of:

(a) C_8-C_{16} aliphatic fatty acid ethoxylates having from 5 to 15 ethylene oxide residues;

(b) C_8-C_{16} alcohol ethoxylates having from 5 to 15 ethylene oxide residues; and

(c) C_8-C_{16} aliphatic amine ethoxylates having from 5 to 15 ethylene oxide residues.

The references relied upon by the examiner as evidence of obviousness are:

Farmer	4,103,051	Jul. 25, 1978
Navratil et al. (Navratil)	4,655,786	Apr. 7, 1987

Claims 1 through 20 stand finally rejected under the

first paragraph of 35 U.S.C. § 112 "as failing to provide a description which will enable one to make and use the invention without undue experimentation" (answer, page 4 in combination with page 6).

Claims 1 through 8 and 10 through 20 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Farmer in view of Navratil.[1]

We cannot sustain either of the above noted rejections.

We find nothing in the comments made by the examiner in the answer concerning her section 112 rejection which supports her proposition that the here claimed invention offends the enablement (or for that matter the written description) requirements of this statute. As correctly indicated by the appellant in the brief, the examiner has simply failed to carry her burden of coming forward with evidence or rationale which establishes a prima facie case of nonenablement (or lack of written description). Indeed, many of the concerns

[1]Contrary to the final rejection, the answer reflects that claims 1 through 20 (rather than just claims 1 through 8 and 10 through 20) are included in the section 103 rejection before us. This inconsistency need not be resolved in light of our disposition of the subject appeal.

expressed by the examiner have no apparent relationship at all to the first paragraph requirements of section 112.

As a consequence of the foregoing, we cannot sustain the examiner's section 112, first paragraph, rejection of claims 1 through 20.

With regard to the section 103 rejection, the examiner concludes that "[i]t would have been obvious to the skilled artisan to use the dyebath of Navratil in the process of Farmer because Navratil teaches that the surfactants have a hydrotroping or solubilizing effect on the disperse dyes, and that if the disperse dyes are dissolved in water with the aid of said surfactants at 70 to 100 degrees centigrade, dyeings can be carried out on polyester at 120-150 degrees centigrade" (answer, page 7). The record presented by this appeal compels us to not agree with the examiner's conclusion of obviousness.

It is well settled that obviousness requires a suggestion to modify as well as a reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1680-1681 (Fed. Cir. 1988). In the case before us, it is questionable

whether these requirements have been satisfied by the examiner. More specifically, we find little if any discussion by the examiner that it would have been reasonable to expect Navratil's dye bath to successfully dye the amine-treated polyester fibers of Farmer. In any event, even considering the aforementioned requirements to be satisfied, the examiner's section 103 rejection would still be improper based on the record before us.

This is because the appellant has explicitly argued that the here claimed invention exhibits indicia of nonobviousness in the form of unexpected results (e.g., see pages 12 and 13 of the brief). According to the appellant, their specification data evinces that the here claimed harmonizing compounds produce unexpectedly superior dye-results relative to the surfactant compounds of Navratil and in particular the surfactant compounds disclosed by patentee which are just outside the class of harmonizing compounds defined by appealed claim 1. On the other hand, the examiner in her answer has proffered no reason at all for considering the appellant's evidence of nonobviousness to be unpersuasive. Indeed, the

examiner has not even acknowledged the fact that the appellant's brief contains assertions of unexpected results. Thus, on the record of this appeal, the appellant's assertions of nonobviousness have not been contested by the examiner and thus must be accepted as persuasive.

For these reasons, we also cannot sustain the examiner's section 103 rejection over Farmer in view of Navratil.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris Administrative Patent Judge	)	
Chung K. Pak Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Thomas A. Waltz Administrative Patent Judge	)	

tdl

Terry T. Moyer
P.O. Box 1927
Spartanburg, SC 29304